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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/328,626	06/09/1999	STEVEN A. BOVE	245-111	7062

570 7590 10/04/2005

AKIN GUMP STRAUSS HAUER & FELD L.L.P.  
ONE COMMERCE SQUARE  
2005 MARKET STREET, SUITE 2200  
PHILADELPHIA, PA 19103

EXAMINER

FELTEN, DANIEL S

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

*JK*

**Office Action Summary**

Application No.

09/328,626

Applicant(s)

BOVE ET AL.

Examiner

Daniel S. Felten

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-62 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Status of Claims*

1. Remarks filed on June 16, 2005 pointing to statements in the Amendment filed March 3, 2005 clarifying the location of exhibits to be identical to those submitted within the Declaration of the Prior Invention filed July 14, 2004 is acknowledged. Thus claims 1-62 remain pending and are unamended.

### *Status of 37 C.F.R. § 1.131 Declaration*

2. Upon further consideration of the affidavit filed July 14, 2004, it was found that the facts presented are incomplete and insufficient to overcome Wallman or Moran because of the following asserted reasons:

--The rule requires that the affidavit set forth facts which show a completion of invention. Upon further consideration, the rule emphasizes that the facts be of such character and weight *"as to establish reduction to practice prior to the effective date of the reference."* A mere statement that the invention was reduced or that the applicant exercised due diligence *is not enough* to satisfy the rule. The rule requires that the affidavit set forth enough actual facts to permit the Examiner to make his own assessment as to whether there was conception, an actual reduction to practice or diligence [see *In re Harry*, 333 F.2d 920, 142 USPQ 164 (CCPA 1964)]. If the applicant is relying upon conception and diligence (as it seems the case is here) in order that the Examiner may determine whether reasonable diligence was exercised, the affidavit **must** set forth acts relied upon *as well as the dates* when those acts were performed. If dates for

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the acts relied upon are not specified it would be impossible to determine whether diligence was exercised [see MPEP 715.07].

--In the simplest factual situation, in order to "swear in the back of" that reference under rule 131, the applicant should submit an affidavit setting forth the necessary facts to establish that he made and/or tested the invention prior to the effective date of the reference. *The affidavit should also be accompanied by any documentary evidence such as laboratory notebooks, test reports, etc.* However, The affiant may not merely point to documentary exhibits attached to the affidavits as establishing that the applicant completed the invention prior to the reference date. It is the responsibility of the affiant to clearly explain the documentary exhibits attached to the affidavits as establishing attached to the affidavits as establishing that the applicant completed the invention prior to the reference date. It is the responsibility of the affiant to clearly explain the documentary exhibits and indicate what the exhibits are intended to evidence in addition to the averment of the acts which he is relying upon [see *In re Borkowski*, 505 F.2d 713, 184 USPQ 29 (CCPA 1974)].

--It is also respectfully asserted for the applicant to consider the fact that the 35 U.S.C. § 103(a) rejection was based upon a combination of references, Moran and Wallman, and that the applicant must establish that he not only made the limitations relied upon by the reference, but must also establish the applicant had possession of either the whole invention claimed or something falling within the claim in the sense that the claim as a whole reads on it." [see *In re Tanczyn*, ]

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Thus for the reasons asserted above, the applicant's affidavit filed July 14, 2004 is not longer consider sufficient to overcome the references used in 35 U.S.C. § 103(a) rejections filed January 19, 2005. Thus these rejections are maintained and are provided below for applicant's convenience.

*Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moran (US 6,430,541) in view of Wallman (US 6,601,044).

Moran discloses a computerized process, product and program for automating and executing investment planning for a client comprising (see Moran, col. 17, 11. 48-62),

(a) inputting into a computer data regarding the client's desired asset portfolio, including the taxable status of each asset (see Moran, col. 18, 11. 11-14),

(b) inputting into a computer the client's desired asset allocation (see Moran, col. 18, 11. 11+),\*

(c)... preferred domain (see Moran, col. 17, 11. 48-62),\*

(e) displaying the recommendations on a summary report for review by the client or the client's financial manager (see Moran fig. 49, col. 34, 11. 10+),.

Moran discloses automatically generating financial transaction recommendations (see Moran, see fig. 54), but fails to disclose that the recommendations call for modifying the client's current asset portfolio to reach as close as possible to the desired asset allocation and preferred domain.

Wallman discloses modifying the client current asset portfolio based upon the clients desired allocation (see Wallman, col. 11, 66 to col. 12, 11. 11., and col. 12, lines 34-54) and taxable or tax-deferred status (i.e. 1R.A. 401(k)) (see 1044, col. 13, 01. 17, 34+). It would have been obvious for an artisan of ordinary skill at the time of the invention to employ Wallman

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providing the aforementioned feature so as to provide the client with more control over the client's desired asset allocation.

Moreover it would have been obvious for an artisan of ordinary skill at the time of the invention to employ, the aforementioned features of Wallman into Moran because an artisan the time of the invention would have been motivated to provide the client with control over the client's desired asset allocation accounts that have assets in a taxable or tax-deferred status as a part of the client's total portfolio. Thus such a modification would have been an obvious expedient well within the ordinary skill in the art.

***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel S. Felten whose telephone number is (571) 272-6742. The examiner can normally be reached on Flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Daniel S Felten  
Examiner  
Art Unit 3624

DSF  
September 22, 2005



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SUPERVISORY PATENT EXAMINER  
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